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JUL 08 2004

**OFFICE OF PETITIONS**

In re Application of :  
Orlowski, et al. : DECISION ON PETITION  
Application No. 09/428,982 :  
Filed: October 28, 1999 :  
Atty. Dkt. No.: P3091 :  
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This is a decision on the petition under 37 CFR 1.137(a), filed March 15, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

This application became abandoned September 6, 2003 for failure to timely reply to the final Office action re-mailed June 5, 2003. The final Office action set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136(a) were timely requested. Notice of Abandonment was mailed January 6, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The present petition lacks requirements (1) and (3) above.

As to item (1), petitioner has failed to submit a proper response to the outstanding Office action. While an amendment was submitted with the instant petition, the amendment has been

reviewed by the examiner of record and deemed not to place the application in condition for allowance. Accordingly, any renewed petition must be accompanied by a proper response to the outstanding Office action. A response may be an amendment that places the application in condition for allowance, a request for continued examination (and appropriate fee), a Notice of Appeal (and appropriate fee), or a continuation application (and appropriate fee).

As to item (3), petitioner has failed to present a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner attributes the delay in timely submitting a proper response to the final Office action to non-receipt. In the absence of any irregularity in the mailing of the final Office action, there is a strong presumption that the final Office action was properly mailed to the correspondence address of record. This presumption may be overcome by a showing that the final Office action was not in fact received. However, non-receipt of an Office communication due to failure to promptly

and properly submit a change of correspondence address to the Office is not deemed unavoidable within the meaning of 37 CFR 1.137(a).

The final Office action was originally mailed to the correspondence address of record on March 18, 2003<sup>1</sup>. The final Office action was returned to the Office by the USPS as undeliverable as addressed. The Office then re-mailed to the final Office action, resetting the period of time for response, on June 5, 2003<sup>2</sup>. The final Office action was again returned to the Office as undeliverable as addressed. The final Office action mailed June 5, 2003 was forwarded to applicant on December 17, 2003 at the newly submitted change of correspondence address<sup>3</sup>. The mailing on December 17, 2003 did not reset the period of time for reply as implied by petitioner. The final Office action was forwarded by the Technology Center clerical staff as a courtesy, and, presumably as requested by petitioner.

Petitioner is advised as per MPEP 711.03(c) that where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The following do not constitute proper notification of a change in correspondence address: (A) the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made; (B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP §

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<sup>1</sup> The correspondence address of record as of the date of mailing of the final Office action was Rockey Milnamow & Katz Ltd., Two Prudential Plaza, Suite 4700, Chicago, IL 60601.

<sup>2</sup> Id.

<sup>3</sup> A change of correspondence address was submitted December 17, 2003.

403); or (C) the lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address.

While petitioner was assigned a customer number in an Office communication mailed May 1, 2002, petitioner is reminded of the requirement to submit a change of correspondence address in each effected application. See, MPEP 601.03. There is no indication in Office records that petitioner submitted a change of correspondence address prior to the mailing of the final Office action on June 5, 2003. In fact, a change of correspondence address was not submitted until December 17, 2003.

Petitioner's failure to properly and promptly submit a change of correspondence address for the instant application, while perhaps unintentional, does not amount to unavoidable delay within the meaning of 37 CFR 1.137(a).

Any renewed petition must establish that the delay in timely replying to the final Office action was unavoidable.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the \$475.00 extension of time fee submitted herewith was subsequent to the maximum period obtainable for reply, this fee is unnecessary. A refund may be requested by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund. Alternatively, petitioner may request to have the petition for extension of time fee applied to the fee for a petition under 37 CFR 1.137(b) as discussed herein.

#### **ALTERNATE VENUE**

Petitioner is **strongly** urged to consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail:

**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile:

(703) 872-9306

By hand delivery or  
courier service (FedEx,  
UPS, DHL, etc.):

U.S. Patent and Trademark Office  
220 20<sup>th</sup> Street S.  
Customer Window, **Mail Stop Petition**  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

Petitioner is advised that the change of correspondence address submitted October 21, 2003 has been entered into the record.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0310.



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Office of Petitions